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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,787	01/05/2001	Paul Robert Carini	YOR920000056US1	5263

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Ryan, Mason & Lewis, LLP  
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Locust Valley, NY 11560

EXAMINER

BELL, PAUL A

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/755,787

Applicant(s)

CARINI ET AL.

Examiner

PAUL A BELL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 1, 18, 22, and 39 the phrase “configured to permit a natural transition” is considered unclear, vague and indefinite because how does one determine what is natural and what is unnatural transition.

With regard to claim 14 and 35, the word "pad-like" renders the claim indefinite because the claim include elements not actually disclosed (those encompassed by "- like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

With regard to claims 3 and 24 it uses the word “watermark-type” by which “-type” extends the scope of the expression so as to render it indefinite.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-5, 7-11, 13-15, 17-20, 22-26, 28-32, 34-36, and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruedisueli et al. (5,838,819).

With regard to claim 1 Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system ( abstract and figure 1), the method comprising the steps of: positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 and 10) ; and physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34); the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format such that the on electronic ink data entered at the digitizing surface is computer parseable based on the one or more fields (column 2, lines 10-31), and the one or more pieces of writing medium being further configured to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16).

With regard to claim 2 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined

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format, such that the user may naturally transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b and 5c).

With regard to claim 3 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark-type form thereon, such that the user may naturally transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).

With regard to claim 4 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label).

With regard to claim 5 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 7 Ruedisueli et al. teaches further comprising the step of the user signaling the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 8 Ruedisueli et al. teaches further comprising the step of the user signaling completion of entry of formatted electronic ink data in accordance with the one or more 15 fields (figure 4, item 42).

With regard to claim 9 Ruedisueli et al. teaches further comprising the step of providing the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

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With regard to claim 10 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 11 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 13 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

With regard to claim 14 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a pad-like grouping (column 11, lines 18-29).

With regard to claim 15 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

With regard to claim 17 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 18 Ruedisueli et al. teaches a method of entering formatted electronic ink data provided in association with a user on a handwriting system (abstract and figure 1), the method comprising the steps of: positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system (figure 2, items 30 and 10); physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that,

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substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figures 2 and 3, item 34); and providing one or more user-specified indications in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 the user can see the ink on the paper), such that the electronic ink data entered in association therewith at the digitizing surface is computer parseable based on the one or more fields (column 2, lines 10-31), and such as to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16).

With regard to claim 19 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 20 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

With regard to claim 22 Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user, the system (abstract and figure 1), comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34); and one or more pieces of writing medium (figure 2, item 30); wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such

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that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith (figure 2), the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figure 2); further wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer parseable based on the one or more fields (column 2, lines 10-31), and the one or more pieces of writing medium are further configured to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16).

With regard to claim 23 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may naturally transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively (figure 5b and 5c).

With regard to claim 24 Ruedisueli et al. teaches wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark-type form thereon, such that the user may naturally transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium (figure 12).



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With regard to claim 25 Ruedisueli et al. teaches wherein the one or more fields of the predefined format are associated with a label (page number is a label).

With regard to claim 26 Ruedisueli et al. teaches wherein the label is associated with an information management function (the page number helps you keep track of your notes).

With regard to claim 28 Ruedisueli et al. teaches, wherein the system is further operative to permit the user to signal the beginning of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 40).

With regard to claim 29 Ruedisueli et al. teaches wherein the system is further operative to permit the user to signal completion of entry of formatted electronic ink data in accordance with the one or more fields (figure 4, item 42).

With regard to claim 30 Ruedisueli et al. teaches wherein the system is further operative to provide the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 31 Ruedisueli et al. teaches wherein the feedback is at least one of auditory and visible (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 32 Ruedisueli et al. teaches wherein the feedback relates to whether or not the user is writing within one of the fields (figures 2 and 3 the user can see the ink on the paper).

With regard to claim 34 Ruedisueli et al. teaches wherein the handwriting system is a personal digital notepad (figure 2 and 12).

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With regard to claim 35 Ruedisueli et al. teaches wherein the one or more pieces of writing medium are bound together to form a pad-like grouping (column 9, line 19).

With regard to claim 36 Ruedisueli et al. teaches wherein at least one of the pieces of writing medium has a carbon paper backing (column 9, line 19).

With regard to claim 38 Ruedisueli et al. teaches, wherein at least one of the pieces of writing medium has the predefined format on only a portion of the writing medium (figure 7c, item 68).

With regard to claim 39 Ruedisueli et al. teaches a handwriting system for entering formatted electronic ink data provided in association with a user (abstract and figure 1), the system comprising: a digitizing surface (figure 2, item 26); a stylus (figure 2, item 34); and one or more pieces of writing medium (figure 2, item 30); wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith (figure 2), the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface (figure 2); further wherein one or more user-specified indications can be provided in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format (figures 2 and 3 the user can see the ink on the paper), such that the electronic ink data entered in association therewith at the digitizing surface is computer parseable based on

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the one or more fields (column 2, lines 10-31), and such as to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields (column 4, lines 5-16).

With regard to claim 40 Ruedisueli et al. teaches, wherein at least one of the user-specified indications comprises at least one of a letter, a symbol and a word (figures 2 and 3 show letters, numbers and a graph).

With regard to claim 41 Ruedisueli et al. teaches wherein at least one of the user-specified indications comprises at least one handwritten stroke (figure 3).

***Allowable Subject Matter***

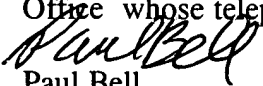
5. Claims 6, 12, 16, 21, 27, 33, 37 and 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

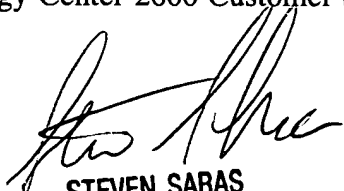
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras, can be reached at (703) 305-9720.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to: (703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

  
Paul Bell  
Art unit 2675  
19 November 2002

  
STEVEN SARAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600